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PATENT

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

IN RE APPLICANT OF: MARK W. THOMPSON
SERIAL NO. : 10/784,056
FILED : February 20, 2004
TITLE : GUARD FOR A GRASS TRIMMING DEVICE
Group/A.U. : 3724
Conf No. : 6854
Examiner : Edward F. Landrum
Docket No. : P0611US0

Mail Stop Reply Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

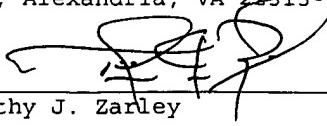
REPLY TO EXAMINER'S ANSWER

Dear Sir:

This brief is submitted in response to the Examiner's Answer of April 20, 2006, and pursuant to 37 CFR § 41.41 in furtherance of the Appeal Brief filed for this case on February 28, 2006.

CERTIFICATE OF MAILING (37 C.F.R. § 1.8(a))

I hereby certify that this document and the documents referred to as enclosed therein are being deposited with the United States Postal Service as First Class mail addressed to: Commissioner for Patents, Alexandria, VA 22313-1450, on this 11th day of May 2006.



Timothy J. Zarley

REMARKS

Claims 1 and 2 stand rejected under 35 U.S.C. 102(b) as being anticipated by Watkins (U.S. Patent No. 6,324,765). Claims 1, 3-9, 11-14 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blevins (U.S. Patent No. 6,327,782) in view of Wright (U.S. Patent No. 5,107,665) in further view of Bridgers (U.S. Design Pat. No. 373,712). Appellant respectfully requests the Board reverse all rejections for the reasons below.

102 Rejection

Claims 1 and 2 stand rejected under 35 U.S.C. 102(b) as being anticipated by Watkins. Anticipation requires the presence of a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim. Lindemann Machinefabrik GmbH v. American Hoist & Derrick Co., 730 F.2d 1452, 1458. (Fed. Cir. 1984).

Claim 1 requires, in part, "a support member slidably connected within the releasable clamp." (Emphasis added). In rejecting the claim, the Examiner asserts that the slidable clamping member is created by the combination of a clamp 5 and a telescoping arm 4 and the support member is taught by an inner arm section 13 that is received within a section of the inner arm. Appellant respectfully disagrees.

The Examiner's proposed combination does not correspond to "a support member slidably connected within the releasable clamp". In contrast, Watkins teaches a telescoping arm or support member formed of two sections, one telescopingly received within the other. (Col. 2, lines 64-65). One of the sections 16, as shown in Fig. 6, is bolted to the outer surface of the clamp 5 and is not slidably connected within the clamp. The second, or inner arm section 13 includes a

pin 14 thereon that is slidably received within an elongated slot 15 on an outer section 16. (Col. 3, lines 1-2). Thus, Watkins teaches a two-piece arm, or support member, where one piece is slidably connected to the other, and not slidably connected within the clamp as is required by claim 1.

For at least the reasons set forth above, Appellant respectfully request that the Examiner's rejection of Claims 1 under 35 U.S.C. 102(b) is reversed. As claim 2 is dependent on claim 1 and recites an additional limitation, Appellant requests that the rejection of claim 2 under 35 U.S.C. 102(b) is also reversed.

103 Rejection

Claims 1, 3-9, 11-14 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blevins in view of Wright and in further view of Bridgers. Appellant respectfully maintains that there is no motivation to combine Blevins, Wright and Bridgers as proposed by the Examiner. The only way based on the teachings of the prior art, to arrive at the present claimed invention, is to use the claim as a blueprint, taking individual, naked parts of separate prior art references together as a mosaic to recreate a facsimile of the present claimed invention. W.L. Core & Associates v. Garlock, Inc., 721 F.2nd, 1540, 1552 (Fed. Cir. 1983).

It is only with the benefit of hindsight that the guard for a grass trimming devices recited in independent claims 1, 6 and 11 can be constructed from bits and pieces of Blevins, Wright and Bridgers. However, even if a motivation could be found to combine the prior art references, the combination would not provide each and every limitation of the rejected claims.

For example, as asserted in the Appeal Brief, none of the three references, either alone or in combination, teach "a support member slidably connected within the releasable clamp," as independent claims 1 and 6 require. Therefore, each and every limitation of claims 1 and 6 would not be present when the prior art references cited are combined and therefore Appellant respectfully asserts that claims 1 and 6 are not obvious in view of the cited references. Claims 2-5 depend on claim 1 and claims 7-9 depend on claim and are thus also considered to overcome the obvious rejection.

Furthermore, independent claims 6 and 11 require that the flexible brush member is positioned at a 90 degree angle to the shaft. None of the prior art references cited by the Examiner teach a flexible brush member that is positioned at a 90 degree angle to a shaft, as asserted in the Appeal Brief. The only way to arrive at the claimed invention would be to take the spatial member of Wright or the shield of Bridgers and replace them with the brush member of Blevins and keep the connection such that it is at a 90 degree angle regardless of the operational consequences of doing so. Appellant submits that this reconstruction to arrive at the claimed invention can only occur if the Appellant's specification and claims are used as a blueprint. Therefore, each and every element of independent claims 6 and 11 are not taught by the prior art references and the claims are considered non-obvious. Claims 7-9 and 16 depend on claims 6 and claims 12-13 depend on claim 11 and thus are all considered to overcome the obvious rejection.

Therefore, in view of the above identified arguments, Appellant respectfully requests that the Board overturn all of the Examiner's rejections set forth in the Final Office

Action mailed October 3, 2005 and submit a Notice of Allowance for claims 1-9, 11-14 and 16.

Conclusion

If any issues remain that may be expeditiously addressed in a telephone interview, the Examiner is encouraged to telephone the undersigned at 515/558-0200.

There are no fees or extensions of time believed to be due in connection with this reply; however, consider this a request for any extension inadvertently omitted, and charge any additional fees to Deposit Account 50-2098.

Respectfully submitted,



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